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09/597,784	06/19/2000	James Crawford	06975-097001	4992

26171 7590 04/09/2004		EXAMINER
FISH & RICHARDSON P.C.		BAUGH, APRIL L

ART UNIT	PAPER NUMBER
2141	

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DATE MAILED: 04/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-40 and 45-52* is/are pending in the application.

   4a) Of the above claim(s) *41-44* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-40 and 45-52* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____ .

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ .

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____ .

DETAILED ACTION

Response to Amendment

Claims 37-40 are amended, 41-44 are canceled, 45-52 are new, therefore claims 1-40 and 45-52.

Response to Arguments

1.   Applicant's arguments with respect to claims 1, 14, 29-31, and 36 have been considered

but are moot in view of the new ground(s) of rejection.

Claim Objections

2.   Claim 47 objected to because of the following informalities: "The user interface of claim

1" should be "The user interface of claim 45". Appropriate correction is required.

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

2.   Claim1-40 and 45-52 rejected under 35 U.S.C. 103(a) as being unpatentable over US

Patent No. 6,513,066 to Hutton et al. in view of Mattaway et al.

Regarding claims 1, 29, and 31, Hutton et al. teaches a method, apparatus, and computer

program, stored on a computer readable medium for transferring a file from a first client

associated with a first subscriber to a communications system to a second client associated with a

second subscriber to the communications system, the method comprising: connecting from the

first client to a communications system host; establishing a direct connection to the second client

that bypasses the communications system host; and transferring a file over the direct connection

(column 1, lines 37-40 and column 2, lines 7-25 and column 6, lines 28-41).

Hutton et al. does not teach sending a request to the second client to establish a direct

connection to the second client; when the second client accepts the request, establishing a direct

connection to the second client. Mattaway et al. teaches sending, through the communications

system host, a request to the second client to establish a direct connection to the second client;

when the second client accepts the request, establishing a direct connection to the second client

that bypasses the communications system host (column 7, line 54 through column 8, line 9).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention

was made to further modify the direct file transfer system of Hutton et al. by sending a request to

the second client to establish a direct connection to the second client; when the second client

accepts the request, establishing a direct connection to the second client because this creates a

more secure system.

Regarding claims 14, 30, and 36, Hutton et al. teaches a method, apparatus, and a

computer program, stored on a computer readable medium for transferring a file from a first

client associated with a first subscriber to a communications system to a second client associated

with a second subscriber to the communications system, the method comprising: connecting

from the second client to a communications system host; establishing a direct connection to the

first client that bypasses the communications system host; and receiving a file over the direct

connection (column 1, lines 37-40 and column 2, lines 7-25 and column 6, lines 28-41).

Hutton et al. does not teach receiving a request from the first client to establish a direct

connection; accepting the request from the first client; establishing a direct connection to the first

client. Mattaway et al. teaches receiving, through the communications system host, a request

from the first client to establish a direct connection; accepting the request from the first client;

establishing a direct connection to the first client that bypasses the communications system host;

and receiving a file over the direct connection (column 7, line 54 through column 8, line 9).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention

was made to further modify the direct file transfer system of Hutton et al. by receiving a request

from the first client to establish a direct connection; accepting the request from the first client;

establishing a direct connection to the first client because this creates a more secure system.

Referring to claim 45, Hutton et al. teaches a user interface configured to enable to

acceptance or rejection of a file transfer from a first client associated with a first subscriber to a

communications system to a second client associated with a second subscriber to the

communications system, the user interface comprising: a first graphical user interface element

structured and arranged to notify an operator of the second client of a request by the first client to

establish a direct connection to the second client, the request being communicated to the second

client by a communications system host and the direct connection bypassing the communications

system host (column 1, lines 37-40 and column 2, lines 7-25 and column 6, lines 28-41).

Hutton et al. does not teach a first graphical user interface element structured and

arranged to notify an operator of the second client of a request by the first client to establish a

direct connection to the second client, and a second graphical user interface element structured

and arranged to enable an operator of the second client authorize a file transfer over the direct

connection. Mattaway et al. teaches a first graphical user interface element structured and

arranged to notify an operator of the second client of a request by the first client to establish a

direct connection to the second client, the request being communicated to the second client by a

communications system host and the direct connection bypassing the communications system

host; and a second graphical user interface element structured and arranged to enable an operator

of the second client authorize a file transfer over the direct connection (column 7, line 54 through

column 8, line 9). Therefore it would have been obvious to one of ordinary skill in the art at the

time the invention was made to further modify the direct file transfer system of Hutton et al. by a

first graphical user interface element structured and arranged to notify an operator of the second

client of a request by the first client to establish a direct connection to the second client, and a

second graphical user interface element structured and arranged to enable an operator of the

second client authorize a file transfer over the direct connection because this creates a more

secure system.

Regarding claims 2 and 15, Hutton et al. teaches the method of claim 1 and 14, wherein

the request is authenticated by the communications system host (column 11, lines 59-60).

Regarding claims 3 and 16, Hutton et al. teaches the method of claim 1 and 14. wherein

the second client accepts the request based on indicated preferences of the second subscriber

(column 6, lines 28-54).

Regarding claims 4 and 17, Hutton et al. teaches the method of claim 1 and 14, wherein the direct connection is initiated by the second client (column 7, lines 66 through column 8, line 14).

Regarding claims 5 and 18, Hutton et al. teaches the method of claim 1 and 14, wherein the direct connection to the second client is established using an IP address of the second client (column 2, lines 20-25).

Regarding claims 6 and 19, Hutton et al. teaches the method of claim 1 and 14, further comprising displaying a graphical user interface indicating that a direct connection to the second client is established (column 8, lines 41-45).

Regarding claims 7 and 20, Hutton et al. teaches the method of claim 1 and 14, wherein the communications system host comprises an instant messaging host (column 1, lines 19-21 and 46-48).

Regarding claims 8 and 21, Hutton et al. teaches the method of claim 1 and 14, wherein the file comprises a data file (column 4, lines 27-28).

Regarding claims 9 and 22, Hutton et al. teaches the method of claim 1 and 14, wherein the file comprises a text file (column 1, lines 40-42).

Regarding claims 10 and 23, Hutton et al. teaches the method of claim 1 and 14, wherein the file comprises a graphics file (column 1, lines 22-23).

Regarding claims 11 and 24, Hutton et al. teaches the method of claim 1 and 14, wherein the file comprises an audio file (column 1, lines 22-23).

Regarding claims 12 and 25, Hutton et al. teaches the method of claim 1 and 14, wherein the file comprises a video file (column 1, lines 22-23).

Regarding claims 13 and 28, Hutton et al. teaches the method of claim 1 and 14, wherein the direct connection is a socket connection (column 7, lines 21-22).

Regarding claim 26, Hutton et al. teaches the method of claim 14, further comprising receiving an indication that the first subscriber using the first client is composing a message (column 7, lines 36-39).

Regarding claim 27, Hutton et al. teaches the method of claim 26, further comprising receiving the message composed by the first subscriber from the first client (column 7, line 66 through column 8, lines 3).

Referring to claims 32 and 37, Hutton et al. teaches the method of claim 31 and 36 wherein the computer readable medium comprises a disc (column 4, lines 17-19 and 28-30).

Regarding claims 33 and 38, Hutton et al. teaches the method of claim 31 and 36 wherein the computer readable medium comprises a client device (column 3, lines 34-35).

Regarding claims 34 and 39, Hutton et al. teaches the method of claim 31 and 36 wherein the computer readable medium comprises a host device (column 3, lines 34-35).

Regarding claims 35 and 40, Hutton et al. teaches the method of claim 31 and 36 wherein the computer readable medium comprises a propagated signal (column 3, lines 17-21).

Regarding claim 46, Hutton et al. teaches the user interface of claim 45 wherein the first graphical user interface element is a dialog box (Fig.5 & 6, column 9, lines 43-62 and column 10, line 40-column 11, line 3).

Referring to claim 47, Hutton et al. teaches the user interface of claim 45 wherein the second graphical user interface element includes a set of sub elements selectable by the recipient

to authorize or reject establishment of the direct connection (Fig.5 & 6, column 9, lines 43-62 and column 10, line 40-column 11, line 3).

Regarding claim 48, Hutton et al. teaches the user interface of claim 47 wherein the sub elements are option buttons (Fig.5 & 6, column 9, lines 43-62 and column 10, line 40-column 11, line 3).

Referring to claim 49, Hutton et al. teaches the user interface of claim 47 wherein the sub elements include a sub element selectable to authorize the direct connection (Fig.5 & 6, column 9, lines 43-62 and column 10, line 40-column 11, line 3).

Regarding claim 50, Hutton et al. teaches the user interface of claim 47 wherein the sub elements include a sub element selectable to reject the direct connection (Fig.5 & 6, column 9, lines 43-62 and column 10, line 40-column 11, line 3).

Referring to claim 51, Hutton et al. teaches the user interface of claim 47 wherein the sub elements include a sub element selectable to ignore the request (Fig.5 & 6, column 9, lines 43-62 and column 10, line 40-column 11, line 3).

Regarding claim 52, Hutton et al. teaches the user interface of claim 47 wherein the sub elements include a sub element selectable to warn the first client not to send future requests for a direct connection to the second client (Fig.5 & 6, column 9, lines 43-62 and column 10, line 40-column 11, line 3).

Conclusion

1.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents are cited to further show the state of the art with respect to direct file transfer in general:

US Pat No. 5,999,965 to Kelly

US Pat No. 6,347,085 to Kelly

Any inquiry concerning this communication or earlier communications from the examiner should be directed to April L Baugh whose telephone number is 703-305-5317. The examiner can normally be reached on Monday-Friday 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal D Dharia can be reached on 703-305-4003. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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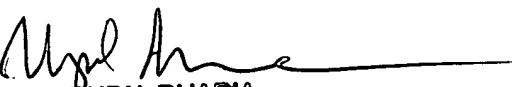
RUPAL DHARIA
SUPERVISORY PATENT EXAMINER